Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIHISA MOTOSUGI and HIROYUKI IDEYAMA

Appeal No. 2001-1855
Application No. 08/897,440

ON BRIEF

Before DIXON, GROSS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-32, which are all the claims in the application.

We reverse.

BACKGROUND

The invention is directed to an image editing apparatus (e.g., within a color copying machine) capable of registering a texture pattern from a document. Representative claim 1 is reproduced below.

1. An image editing apparatus, comprising:

means for obtaining image data;

means for displaying said obtained image data;

means for designating a part of said displayed image data; and

means for registering said designated part of image data as pattern data for use in editing an image.

The examiner relies on the following references:

Wolf et al. (Wolf)	5,459,832	Oct. 17, 1995
Ohmura	5,666,207	Sep. 9, 1997 (filed Apr. 25, 1995)
Hamanaka et al. (Hamanaka)	5,712,713	Jan. 27, 1998 (filed Mar. 17, 1995)

Claims 1-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hamanaka and Wolf.

Claims 15-28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hamanaka, Wolf, and Ohmura.

Claims 29 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hamanaka, Wolf, and applicants' admitted prior art (APA) (specification p. 2, ll. 7-18; Figs. 55 and 56).

Claims 31 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hamanaka, Wolf, Ohmura, and APA.

We refer to the Final Rejection (Paper No. 6) and the Examiner's Answer (Paper No. 13) for a statement of the examiner's position and to the Brief (Paper No. 12) for appellants' position with respect to the claims which stand rejected.

OPINION

Appellants disclose a digital color copying machine that includes a memory 624 (Fig. 3) storing binary data in the forms of patterns for patterning processing. (Spec. at 16, ll. 17-24.) The machine also includes a texture memory 622 (Fig. 3; Fig. 17) that stores the image of a texture document (a document with a pattern to be registered). The data stored in the texture memory is used for processing of texture patterning of a color document. (Id. at 35, ll. 2-14.) A user may enter a registration mode by selection from the menu shown in Figure 22, bringing up the menu of Figure 35. (Id. at 44, ll. 23-24.) A menu for texture registration is depicted in Figure 37. As detailed in the specification at page 46, line 21 through page 49, line 3, a user may place a document with a texture pattern to be registered on the machine platen. By manipulation of the menu selection, a user may scan a texture pattern from the document and register the

read texture pattern into the texture palette. The registered texture pattern in the texture palette may be used as desired by the user during editing another document.

According to the rejection of claims 1-14, the examiner finds (Answer at 3) that Hamanaka discloses the invention, including displaying image data, but does not disclose that the image data is used as pattern data in editing an image. The rejection refers to Wolf for the teaching deemed to be missing from Hamanaka. Wolf is relied upon as teaching that a part of image data is "registered in a memory (412) (a file retrieval and storage mechanism 412) for use in editing an image [col. 9, lines 32-56, figures 4 and 5]." (Answer at 3-4.)

In appellants' view, LCD 126 of Hamanaka displays menu information, but not obtained image data. Appellants quote extensively from the reference (Brief at 14-15) in support of the argument. However, appellants appear to skip column 17, lines 10-13 of the reference.

Hamanaka's apparatus includes a magneto-optical disk 36 for storing image information from a document read by scanner 4. Col. 5, ll. 36-43. Hamanaka at the top of column 17 describes retrieving document information from magneto-optical disk 36 by using a menu on LC display 126. "[B]y depressing the 'display key' on the touch panel 125, the first page of the selected document is displayed on the LC display 70 [sic; 126] and the contents of the document can be confirmed." Col. 17, ll. 10-13.

We thus find appellants' argument that Hamanaka fails to display obtained image data unpersuasive.

Appellants also argue that Wolf does not teach that the stored image files are registered as pattern data for use in editing an image. "Rather, Wolf merely provides that objects edited can be stored and retrieved from a memory." (Brief at 18.) The examiner responds (Answer at 8) that Wolf's invention does teach registering the designated part of the image data as pattern data for use in editing an image and refers back to the statement of the rejection.

We find that, consistent with appellants' arguments, Wolf discloses storage and retrieval of image files in the section that the examiner asserts the teaching to be found (i.e., col. 9, ll. 32-56; Figs. 4 and 5). Since Wolf does not expressly disclose the teaching attributed to it, the rejection can only stand if Wolf inherently discloses registering image data "as pattern data for use in editing an image," as required by each of independent claims 1 and 8.

Our reviewing court has set out clear standards for establishing inherency.

> To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient."

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

In the instant case, the examiner has not provided evidence that registering image data as pattern data for use in editing an image is necessarily the same as the

storage and retrieval of image data disclosed by Wolf. Nor do we find any convincing rationale as to why Wolf may be deemed to teach that which the rejection attributes to the reference. Nor does the rejection offer any interpretation of the relevant claim terms to show that an artisan would consider the teachings of Wolf as falling within the ambit of the claims.

"[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In view of the requirements for establishing inherency, we cannot simply attempt to fill in the gaps in the instant rejection by adding our speculation to the express teachings of the references.

The examiner bears the initial burden of presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In view of appellants' contesting of an essential finding in support of a conclusion of obviousness, the finding being unsupported by evidence in this record, we do not sustain the rejection of claims 1-14 under 35 U.S.C. § 103 as being unpatentable over Hamanaka and Wolf. Since the remaining rejections depend on Wolf for the teaching that appellants have shown to be deficient, neither do we sustain the section 103 rejections of claims 15-32.

CONCLUSION

The rejection of claims 1-32 under 35 U.S.C. § 103 is reversed.

REVERSED

JOSEPH L. DIXON Administrative Patent Judge	)
ANITA PELLMAN GROSS Administrative Patent Judge	) BOARD OF PATENT) APPEALS) AND) INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)

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